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09/785,700	02/16/2001	Robert M. Szabo	6169-156	4280
40987	7590	03/22/2006	EXAMINER	
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 03/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/785,700

Applicant(s)

SZABO ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-13 and 16-24 have been examined. Application 09/785,700 (METHOD AND APPARATUS FOR STIMULATING COMMERCE) has a filing date 02/16/01.

### **Response to Amendment**

2. In response to Advisory Action filed 09/29/2005, the Applicant filed an RCE on 12/27/2005, which amended claims 1-3, 6, 10, 16-24 and cancel claims 14 and 15.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 paragraph 5 recites the limitation "associating **said** promotional material corresponding to said at least one merchant-specified product". There is insufficient antecedent basis for this limitation in the embodiment of the claim.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "the at least one related product being a product that is consumed jointly with the at least one merchant-specified product". Nowhere, in the Applicant specification said limitation is described or

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explained. The only places in Applicant's specification that the term "related product" is mentioned is in Applicant's specification page 18, lines 14-17 where it recites "SSLU need not access only promotional material for the exact product needed by the consumer, but rather can access promotional materials for equivalent, similar or **related products** corresponding to the products needed by the identified consumers". Applicant's argues that Applicant's specification page 22, lines 13-15 teaches said limitation, however, Applicant's specification page 22, lines 13-15 recites "The CSS also can track the purchase history of a consumer relating to one or more products to determine product consumption rate information". Said page 22 does not mentioned the term "related product" and "relating to one or more products" is not the same as "related product". However, nowhere in said cited part of Applicant's specification is taught or described the limitation that "the at least one related product being a product that is consumed jointly with the at least one merchant-specified product".

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-13, 16, 18-21, 23 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Barenbaum (US 2001/0039514).

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As per claim 10, Barenbaum teaches:

A system for providing promotional material to consumers comprising:

A system configured to generate a merchant request to stimulate commerce for at least one merchant-specified product;

*a merchant inventory management system configured to track and statistically establish a norm of an inventory level of the at least one merchant-specified product based on received shipments and sales by the merchant of the at least one merchant-specified product (see paragraphs 18 and 50);*

*a shopping stimulation logic unit in communication with said merchant inventory management system for detecting a business necessity of the merchant and identifying one or more potential consumers of the at least one merchant-specified product in response to the business necessity, wherein said shopping stimulation logic unit detects the business necessity by detecting when the inventory level of the at least one merchant-specified product deviates from the established norm by more than a pre-selected threshold (see paragraphs 18, 19, 21 and 50);*

a promotional information database, accessible by said shopping stimulation logic unit, for storing promotional information relating to said at least one merchant-specified product (see paragraph 21) and

a promotional material delivery system configured to make said promotional material available to said identified consumers (see paragraph 21).

As per claim 16, Barenbaum teaches:

*A computer-implemented method of providing promotional material to consumers comprising:*

*generating in a merchant computer system a merchant request to stimulate commerce for at least one merchant-specified product when a product life-cycle of said merchant-specified product is determined (see paragraphs 18, 19 and 21);*

*establishing a computer communications session between the merchant computer system and a third-party remote shopping stimulation system, wherein the merchant request is conveyed to the third-party remote shopping stimulation system (see paragraphs 30-31);*

*reading with said third-party remote shopping stimulation system consumer purchase information from a plurality of merchant computer systems, said consumer purchase information comprising consumer identifying information and product information (see paragraphs 21 and 35);*

*determining an end of a product life-cycle of the merchant-specified product and, in response thereto, identifying one or more potential consumers of the at least one merchant-specified product based at least in part on said consumer purchase information (see paragraphs 18, 19 and 21);*

*in said third-party remote shopping stimulation system, associating said promotional material corresponding to said at least one merchant-specified product with said identified consumers (see paragraph 21); and*

*making said promotional material available to said identified consumers using a promotional material delivery system (see paragraph 21).*

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As per claim 11, Barenbaum teaches:

The system of claim 10, further comprising:

a consumer purchase information data structure for storing consumer identifying information and product information corresponding to a purchase transaction (see paragraph 35).

As per claim 12, Barenbaum teaches:

The system of claim 10, further comprising:

a commerce system for collecting said consumer purchase information in a computer communications network environment (see paragraph 35).

As per claims 13 and 18, Barenbaum teaches:

The method of claim 10, wherein said promotional material and said consumer purchase information include person-to-person transactions and Internet-based transactions (see paragraphs 23 and 41).

As per claim 19 Barenbaum teaches:

The method of claim 16, wherein each said step is performed responsive to the merchant system detecting a business necessity, wherein said business necessity is at least one of an associated merchant having excess inventory and an associated merchant experiencing a revenue shortfall (see paragraphs 18-19 and 21).

As per claim 20, Barenbaum teaches:

The method of claim 16, wherein said consumer purchase information is read from a purchase history database comprising consumer purchase information for a plurality of different merchants, and wherein the third-party remote shopping stimulation

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system responds to merchant requests from said plurality of different merchants (see paragraphs 47-48).

As per claim 21, Barenbaum teaches:

The method of claim 16, wherein said at least one merchant-specified product is a service (see paragraph 18).

As per claim 23, Barenbaum teaches:

The method of claim 16, wherein said promotional material made available to said identified consumers is in electronic format (see paragraph 21).

As per claim 24, Barenbaum teaches:

The method of claim 16, wherein said promotional material made available to said identified consumers is in printed format (see paragraph 5).

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barenbaum (US 2001/0039514) in view of Deaton (US 6,611,811).



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As per claims 1, Barenbaum teaches:

A *computer-implemented* method of providing promotional material to consumers comprising:

generating *in a merchant computer system* a merchant request to stimulate commerce for at least one merchant-specified product (see paragraph 21);

establishing a computer communications session between the merchant computer system and a third-party remote shopping stimulation system wherein the merchant request is conveyed to the third party shopping stimulation system (see paragraphs 29; 48) ;

reading *with said third-party remote shopping simulation system* consumer purchase information from *a plurality of* merchant computer systems, said consumer purchase information comprising consumer identifying information and product information (see paragraph 48);

based at least in part on said consumer purchase information, identifying one or more potential consumers *who have purchased at least one related product related to* the at least one merchant-specified product (see paragraphs 21, 48 and 50)

in said third-party remote shopping stimulation system, associating said promotional material corresponding to said at least one merchant-specified product with said identified consumers (see paragraphs 18, 19 and 21) and

making said promotional material available to said identified consumers using a promotional material delivery system (see paragraph 21).

Barenbaum fails to teach to teach *the at least one related product being a product that is consumed jointly with the at least one merchant-specified product*. However, Deaton teaches a system to provide a method of maximizing purchases to a product group based upon the actual average consumption of this product and related product (see column 116, lines 55-62). Also, Deaton teaches the identification of a consumer's purchase of a related product (i.e. disposable baby diapers; see Deaton column 87, lines 55-65) that is consumed jointly with the at least one merchant-specified product (i.e. baby wipes, baby food; see Deaton column 87, lines 55-65) for the purpose of targeting incentives to consumers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Barenbaum would be motivated to track consumers purchases of merchant-specified products and related products, as taught by Deaton in order to better target promotions to consumers based upon said consumers purchase transaction and merchants' inventories. Merchants would be motivated to keep track of over-stocked inventory or low revenues products (see Barenbaum paragraphs 18-19) and alert consumers of promotions based upon a match between said over-stocked inventory and said consumers' purchase transactions in order to improve the capacity management of time sensitive products or services and therefore, offset over capacity or low revenues.

As per claim 2, Barenbaum fails to teach:

The method of claim 1, said identifying step further comprising determining a product consumption rate from said consumer purchase information to identify said one or more potential consumers of the least one merchant-specified product. However,

Deaton teaches "A consumption rate analysis is performed based on historical product purchases. Non-perishable products that may typically be consumed over a period of more than one week are analyzed to determine the rate in which they are consumed for each ID. This consumption rate is compared with the date of last purchased so that a prediction of next purchase may be made" (see Deaton column 70, lines 4-25; column 90; column 118, lines 52-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Barenbaum would make a consumption rate analysis for perishable products, which typically need to be consumed in less than one week, such as milk, as taught by Deaton in order to target incentives to customers based upon a match between said perishable product due date and a merchant over-stocked or low revenue products. This feature would allow the Barenbaum system improve the capacity management of time sensitive products or services and therefore, offset over capacity or low revenues.

As per claim 3, Barenbaum teaches:

The method of claim 1, wherein said promotional material and said consumer purchase information include person-to-person transactions and Internet-based transactions (see paragraphs 23 and 41).

As per claim 4, Barenbaum teaches:

The method of claim 1, wherein each said step is performed responsive to the merchant system detecting a business necessity, wherein said business necessity is at least one of an associated merchant having excess inventory and an associated merchant experiencing a revenue shortfall (see paragraphs 18-19 and 21).

As per claim 5, Barenbaum teaches:

The method of claim 1, wherein said consumer purchase information is read from a purchase history database comprising consumer purchase information for a plurality of different merchants, and wherein the third-party remote shopping stimulation system responds to merchant requests from said plurality of different merchants (see paragraphs 47-48).

As per claim 6, Barenbaum teaches:

The method of claim 1, wherein said at least one merchant-specified product is a service (see paragraph 18).

As per claim 7, Barenbaum fails to teach:

The method of claim 1, said product information comprising product expiration information and product identifying information wherein said step of identifying one or more potential consumers of products is *additionally* based upon the expiration information of products. However, Deaton teaches "A consumption rate analysis is performed based on historical product purchases. Non-perishable products that may typically be consumed over a period of more than one week are analyzed to determine the rate in which they are consumed for each ID. This consumption rate is compared with the date of last purchased so that a prediction of next purchase may be made" (see

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Deaton column 70, lines 4-25; column 90; column 118, lines 52-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Barenbaum would make a consumption rate analysis for perishable products, which typically need to be consumed in less than one week, such as milk, and would transmit incentives to customers for such perishable products, when the product expiration is due, as taught by Deaton. This feature would allow the Barenbaum system to track perishable and non-perishable products and send corresponding incentives when the next due date to purchase a type of product arrives.

As per claim 8, Barenbaum teaches:

The method of claim 1, wherein said promotional material made available to said identified consumers is in electronic format (see paragraph 21).

As per claim 9, Barenbaum teaches:

The method of claim 1, wherein said promotional material made available to said identified consumers is in printed format (see paragraph 5).

As per claim 17, Barenbaum fails to teach:

The method of claim 16, said identifying step further comprising determining a product consumption rate from said consumer purchase information to identify said one or more potential consumers of the least one merchant-specified product. However, Deaton teaches "A consumption rate analysis is performed based on historical product purchases. Non-perishable products that may typically be consumed over a period of more than one week are analyzed to determine the rate in which they are consumed for each ID. This consumption rate is compared with the date of last purchased so that a

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prediction of next purchase may be made" (see Deaton column 70, lines 4-25; column 90; column 118, lines 52-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Barenbaum would make a consumption rate analysis for perishable products, which typically need to be consumed in less than one week, such as milk, and would transmit incentives to customers for such perishable products, when the product expiration is due, as taught by Deaton and when Barenbaum system notice a over-stocked or low revenue for said perishable products. This feature would allow the Barenbaum system to track perishable and non-perishable products and send corresponding incentives when the next due date to purchase a type of product arrives.

As per claim 22, Barenbaum fails to teach:

The method of claim 16, said product information comprising product expiration information and product identifying information wherein said step of identifying one or more potential consumers of products is *additionally* based upon the expiration information of products. However, Deaton teaches "A consumption rate analysis is performed based on historical product purchases. Non-perishable products that may typically be consumed over a period of more than one week are analyzed to determine the rate in which they are consumed for each ID. This consumption rate is compared with the date of last purchased so that a prediction of next purchase may be made" (see Deaton column 70, lines 4-25; column 90; column 118, lines 52-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Barenbaum would make a consumption rate analysis for perishable

products, which typically need to be consumed in less than one week, such as milk, and would transmit incentives to customers for such perishable products, when the product expiration is due, as taught by Deaton. This feature would allow the Barenbaum system to track perishable and non-perishable products and send corresponding incentives when the next due date to purchase a type of product arrives.

### ***Response to Arguments***

6. Applicant's arguments filed 12/27/2005 have been fully considered but they are not persuasive. Applicant argues that neither Gardenswartz nor Deaton teaches the limitation "the at least one related product being a product that is consumed jointly with the at least one merchant-specified product". The Examiner answers that nowhere, in the Applicant specification said limitation is described or explained. The only places in Applicant's specification that the term "related product" is mentioned is in Applicant's specification page 18, lines 14-17 where it recites "SSLU need not access only promotional material for the exact product needed by the consumer, but rather can access promotional materials for equivalent, similar or **related products** corresponding to the products needed by the identified consumers". Applicant's argues that Applicant's specification page 22, lines 13-15 teaches said limitation, however, Applicant's specification page 22, lines 13-15 recites "The CSS also can track the purchase history of a consumer relating to one or more products to determine product consumption rate information". Said page 22 does not mentioned the term "related product" as the Applicant's argues because "relating to one or more products" is not the term "related product".

The Applicant further argues that “a related product, termed a complementary good or service by economist, is related to another product because both are consumed or used jointly” and then cited a book from Stigler Price. Furthermore, the Applicant argues that “ham and egg” are complementary products but “ham and pharmacy” are not, and that “chips” are complementary to “colas or beer” or to “salsa or dip” and that Gardenswartz does not teach said complementary products. The Examiner answers that nowhere in Applicant's specification said limitation is described. Dictionary.com defines “related” as “being connected; associated” but not jointly consumed or used together, and the definition of what a product is consumed jointly with another is very variant. For example, for the Examiner ham is not complementary to egg, as the Examiner never eats eggs with ham. For the Examiner butter is complementary to egg or bread is complementary with garlic. Therefore, Applicant definition of what is a complementary product and what is not, is not correct. Also, the Applicant cited book does not teach that egg is complementary to ham or that chip is complementary to salsa. Therefore, the Applicant is arguing about limitation that are not described or explained in the Applicant's specification.

Applicant's other arguments with respect to claims 1-13 and 16-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

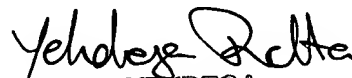


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Lastra  
March 4, 2006

  
RETTA YEHDEGA  
PRIMARY EXAMINER